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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,994

08/10/2006

Hisao Nemoto

060596

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23850 7590 04/02/2009
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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

04/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Claims 1-4, are pending in this application.

DETAILED ACTION

Election/Restriction

Claims 1-4 are drawn to more than one inventive concept (as defined by PCT Rule 13) and, accordingly, a restriction is required according to the provision of PCT Rule 13.2.

PCT Rule 13.1 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention).

PCT Rule 13.2 states that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Annex B, Part 1(b), provides that special technical features mean those technical features which, as a whole, define a contribution over the prior art (novelty/unobviousness).

- I. Claims 1, 3-4, drawn to compounds of formulae 1-3, wherein the condensed polycyclic is 5-fluorenylidene, classifiable in several non-heterocyclic classes and numerous subclasses.
- II. Claims 1, 3-4, drawn to compounds of formulae 1-3, wherein the condensed polycyclic is bis(4-cyclohexylphenyl)-methyl, classifiable in several non-heterocyclic classes and numerous subclasses.
- III. Claims 1, 3-4, drawn to compounds of formulae 1-3, wherein the condensed polycyclic is 4-, or 3-(9-phenanthryl)phenyl, classifiable in several non-heterocyclic classes and numerous subclasses.
- IV. Claims 1, 3-4, drawn to compounds of formulae 1-3, wherein the condensed polycyclic is 4-(1-pyrenyl)phenyl, classifiable in several non-heterocyclic classes and numerous subclasses.
- V. Claims 1, 3-4, drawn to compounds of formulae 1-3, wherein the condensed polycyclic is 4-(5-acenaphthenyl)phenyl, classifiable in several non-heterocyclic classes and numerous subclasses.
- VI. Claims 1, 3-4, drawn to compounds of formulae 1-3, wherein the condensed polycyclic is 4-(9-anthryl)phenyl, classifiable in several non-heterocyclic classes and numerous subclasses.

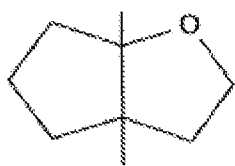
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VII. Claims 1, 3-4, drawn to compounds of formulae 1-3, wherein the condensed polycyclic is 4-(fluorenyl)phenyl, classifiable in several non-heterocyclic classes and numerous subclasses.

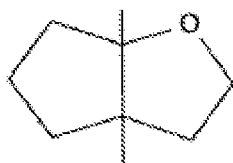
VIII. Claims 1, 3-4, drawn to compounds of formulae 1-3, wherein the condensed polycyclic is 2-naphthyl or 4-bromophenyl, classifiable in several non-heterocyclic classes and numerous subclasses.

IX. Claim 2, drawn to method of using compounds of formulae 1-3, classifiable in several non-heterocyclic classes and numerous subclasses.

1. In the instant inventions, the only structural element shared by groups I-IX is

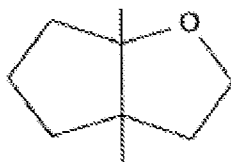


. (The lines at positions 11 and 12 are bonds not methyl groups.)



However,

is well known in the art. See WO 2002/072505. Therefore,



under PCT Rules 13.1 and 13.2,

does not constitute a corresponding

special technical feature among the groups.

2. If group IX is elected applicant must elect one of groups I-VIII and group IX would be examined commensurate in scope with the elected compound group. In an election of any of Groups I-IX, an election of a single compound (or set of compounds) is further required including an exact definition of each substitution on the base molecule (Formula I), wherein a single member at each substituent group or moiety is selected. For example, if a base molecule has a substituent group R1, wherein R1 is recited to be any one of H, OH, COOH, aryl, alkoxy, halogen, amino, etc., then applicant must select a single substituent of R1, for example OH or aryl, and each subsequent variable position.

In the instant case, Applicant must elect one representative for each of R1-R12, which is the same in formulae 1-3, and the point of attachment of each elected substituent must be specified. The elected substituents must be specific not generic so as to define a species common to formulae 1-3, and the species must be disclosed in the specification. Part of the species corresponding to each substituent in formulae 1-3 must be identified.

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All compounds falling outside the class(es) and subclass(es) of the selected compounds and any other subclass encompassed by the election above will be directed to nonelected subject matter and will be withdrawn from consideration under 35 U.S.C. 121 and 37 C.F.R.

1.142(b). Applicant may reserve the right to file divisional applications on the remaining subject matter. The provisions of 35 U.S.C. 121 apply with regard to double patenting covering divisional applications.

If desired upon election of a single compound, applicants can review the claims and disclosure to determine the scope of the invention and can **set forth** a group of compounds, which are so similar within the same inventive concept and reduction to practice. Markush claims must be provided with support in the disclosure for each member of the Markush group. See MPEP 608.01(p). Applicant should exercise caution in making a selection of a single member for each substituent group on the base molecule to be consistent with the written description.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Rejoinder

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully

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examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the examiner before the patent issues withdraws the restriction requirement. See MPEP § 804.01.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

/Taofiq A. Solola/

Primary Examiner, 1625

March 28, 2009

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